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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,752	08/07/2001	Manceesh Jain	2002850-0015	3181

24280 7590 01/12/2005

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EXAMINER

DO, PENSEE T

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,752

Applicant(s)

JAIN ET AL.

Examiner

Pensee T. Do

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-112 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-68, drawn to a device for forming an array of magnetic particles comprising a substrate comprising a plurality of magnetic regions, classified in class 209, subclass 609.
- II. Claims 69-73, 78, 83-85, drawn to a randomly ordered array of magnetic particles, classified in class 436, subclass 526.
- III. Claims 74-77, 79-82, drawn to a method of forming the array of magnetic particles by contacting the substrate with magnetic particles, classified in class 438, subclass 3.
- IV. Claims 86-109 drawn to a method of analyzing a sample comprising contacting the sample with magnetic particles attached to a probe, forming an array of magnetic particles and determining interactions of the target in the sample with the probe, classified in class 210, subclass 695.
- V. Claims 110-112, drawn to a method of fabricating a device comprising providing a substrate, producing magnetic regions in or on the substrate, classified in class 117, subclass 216.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the

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apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus is not an obvious apparatus for making the product and the apparatus can be used for making a different product. The apparatus is used for making a different product such as a medium for providing magnetic force to attract magnetic particles. The apparatus is not an obvious apparatus for making the product because the product, magnetic particle array, can be made by applying a magnetic force from another device such as a magnet to magnetic particles in solution contained in a beaker and the magnetic particles would form an array at the bottom of the beaker.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process can be practiced by another materially different product such as using a magnet to apply magnetic force to the bottom of a beaker containing the magnetic particles and the magnetic particles would form an array at the bottom of the beaker.

Inventions IV and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation because invention IV is a method of analyzing a sample

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comprising contacting the sample with magnetic particles attached to a probe, forming an array of magnetic particles and detecting. The method of invention IV does not require the use of a substrate with magnetic regions (group I).

Inventions V and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as the process of providing a magnet because the magnet comprises a substrate and magnetic regions.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as coating the magnet with a probe and contacting a plurality of magnetic particles coated with a binder that binds to the probe on the magnet.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product (MPEP § 806.05(h)). In the instant case the process of using can be practiced with another materially different product such as latex particles.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because they are not disclosed as capable of use together and having different modes of operation, different functions and different effects. Invention V is a method of fabricating the device comprising a substrate with magnetic regions while invention II is an array of magnetic particles and a substrate. Invention V has method steps which invention II fails to require. Invention II has magnetic particles which invention V fails to require. Thus, they have different modes of operations, different effects.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because they are not disclosed as capable of use together and have different modes of operation, different effects, and different functions. Invention IV is a method of analyzing the sample using magnetic particles and a probe while invention III is a method of forming an array of particles by contacting the magnetic particles with a substrate with magnetic regions. These two methods have different method steps and different components, which are not capable

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of use together. They also have different effects, one is a method of analyzing which requires a detection step and the other is a step of fabricating a product.

Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different effects and are not disclosed as capable of use together. Invention V is a method of fabricating a device comprising a substrate while invention III is a method of forming an array of magnetic particles. These two methods have different steps and the products formed are different, one is a substrate with magnetic regions and the other is an array of magnetic particles. Thus, the modes of operations are different and these methods are not disclosed as capable of use together because the method of forming a substrate with magnetic regions does not require the use of the method of forming an array of magnetic particles.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation because they comprise different method steps, one is a method of analyzing a target which requires a detection step and the other is a method of fabricating a product which does not require the contacting step between the sample and the probe and a detection step. They are

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not disclosed as capable of use together because the method of analyzing the sample does not require the use of a substrate or device with magnetic regions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III, IV or V, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do
Patent Examiner
January 6, 2005


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800/641
1/6/05